

REMARKS

The Examiner is thanked for the thorough review and examination of this application. The Office Action, however, tentatively rejected all claim 1-20. Claim 10 is amended to add the feature of "the third electronic element is positioned between the first circuit board and the second circuit board." After entry of the foregoing amendment, claims 1-20 remain pending in this application and reconsideration and withdrawal of the rejections is respectfully requested based on the following remarks.

Rejection according to 35 USC 102

The Office Action rejected claims 1-9 under 35 U.S.C. § 102(a) as allegedly anticipated by U.S. published application 2005/0078446A1 to Bae. Applicants respectfully disagree.

Regarding claim 1, independent claim 1 recites:

1. A plasma display, comprising:
 - a base plate;
 - a back cover engaged with the base plate to form a space;
 - a first circuit board disposed in the space and mounted on the base plate;
 - a first electronic element *disposed on the first circuit board*;
 - a first thermal conductive device disposed between the first electronic element and the back cover and mounted on the first electronic element.

(Emphasis added.)

As recited above, claim 1 defines that the first electronic element of the application is disposed on the first circuit board. In Bae, however, the first electronic element 61a is, instead, disposed on the base plate 50 rather than on the first circuit board 60. This is at least one feature of claim 1 that defines over the teachings of Bae, such that Bae cannot properly form the basis of a rejection under 35 U.S.C. § 102.

Regarding claims 2 and 3, the rejection according to 35 USC 102 is overcome by at least their dependency from claim 1.

Regarding claims 4 and 5, the claimed thermal conductive spring provides thermal contact between the back cover and the first electronic element. The elastic structure of the thermal conductive spring can also adjust automatically to adapt for distance variation between the back cover and the first electronic element due to assembly inaccuracy. In Bae, however, the heat transfer medium 71 is formed by sealing a liquid heat dissipation material in a thermal container and bonded between the back cover and the first electronic element. For at least this reason, the structure of the thermal spring of claims 4 and 5 patently defines over the heat transfer medium 71 of the Bae, and for at least this reason the rejection of claims 4 and 5 should be withdrawn.

Regarding claims 6-9, the rejection according to 35 USC 102 is overcome by at least their dependency from claim 1.

Rejection according to 35 USC 103

The Office Action rejected claims 10-20 under 35 U.S.C. § 103(a) as allegedly obvious in view of the combination of Bae and U.S. patent 5,268,815 to Cipolla. For at least the following reasons, Applicants disagree.

Claim 10 (as amended) recites:

- 10. The plasma display as claimed in claim 3 further comprising:
 - a second circuit board mounted between the first circuit board and the base plate;
 - a third electronic element disposed on the second circuit board *and positioned between the first circuit board and the second circuit board.*

As recited above, the third electronic element is defined to be between the first circuit board and the second circuit board. In Clipolla, however, the third electronic element is between the second circuit board 54 and the base plate. Therefore, even combined, the combination of the Bae and Clipolla does not teach the embodiment of claim 10. For at least this reason, the rejection of claim 10 should be withdrawn.

Regarding claims 11-14, the rejection according to 35 USC 103 should be withdrawn for at least the reason that the claims depend from claim 10 and patentably define over the cited art for at least the same reason.

Regarding claims 15 and 16, these claims define that the thermal conductive spring thermally contacts between the back cover and the first electronic element. The elastic structure of the thermal conductive spring can also adjust automatically to adapt for distance variation between the back cover and the first electronic element due to assembly inaccuracy. In Bae, however, the heat transfer medium 71 is formed by sealing a liquid heat dissipation material in a thermal container and bonded between the back cover and the first electronic element. The heat transfer medium 71 is fixed and cannot adapt for the distance variation. The claimed embodiments, therefore, are different from the relevant teachings of Bae, and for at least this additional reason the rejection of claim 15 and 16 should be withdrawn.

Regarding claims 17-20, the rejection according to 35 USC 103 should be withdrawn for at least the reason that these claims depend from claim 10 and therefore define over the cited art for at least the same reason.

In addition to the distinctions set forth above, Applicants respectfully traverse the rejections of claims 10-20 for the following additional reasons. The Office Action rejected these

claims under 35 U.S.C. § 103(a) as allegedly unpatentable over the combination of Bae in view of Cipolla. However, Applicant respectfully submits that the Office Action has failed to cite a proper motivation or suggestion for combining these cited references. In this regard, the Office Action stated only that the combination would have been obvious "to increase the number of electronic elements that can be enclosed within the plasma display" and "to more securely constrain the circuit board to the back cover." (Office Action, p. 5). These alleged motivations are clearly improper in view of well-established Federal Circuit precedent.

It is well-settled law that in order to properly support an obviousness rejection under 35 U.S.C. § 103, there must have been some teaching in the prior art to suggest to one skilled in the art that the claimed invention would have been obvious. W. L. Gore & Associates, Inc. v. Garlock Thomas, Inc., 721 F.2d 1540, 1551 (Fed. Cir. 1983). More significantly,

"The consistent criteria for determination of obviousness is whether the prior art would have suggested to one of ordinary skill in the art that this [invention] should be carried out and would have a reasonable likelihood of success, viewed in light of the prior art. ..." Both the suggestion and the expectation of success must be founded in the prior art, not in the applicant's disclosure... In determining whether such a suggestion can fairly be gleaned from the prior art, the full field of the invention must be considered; for the person of ordinary skill in the art is charged with knowledge of the entire body of technological literature, including that which might lead away from the claimed invention."

(*Emphasis added.*) In re Dow Chemical Company, 837 F.2d 469, 473 (Fed. Cir. 1988).

In this regard, Applicants notes that there must not only be a suggestion to combine the functional or operational aspects of the combined references, but that the Federal Circuit also requires the prior art to suggest both the combination of elements and the structure resulting from the combination. Stiftung v. Renishaw PLC, 945 Fed.2d 1173 (Fed. Cir. 1991). Therefore, in order to sustain an obviousness rejection based upon a combination of any two or more prior art references,

the prior art must properly suggest the desirability of combining the particular elements to derive a plasma display panel, as claimed by the Applicants.

When an obviousness determination is based on multiple prior art references, there must be a showing of some “teaching, suggestion, or reason” to combine the references. Gambro Lundia AB v. Baxter Healthcare Corp., 110 F.3d 1573, 1579, 42 USPQ2d 1378, 1383 (Fed. Cir. 1997) (also noting that the “absence of such a suggestion to combine is dispositive in an obviousness determination”).

Evidence of a suggestion, teaching, or motivation to combine prior art references may flow, inter alia, from the references themselves, the knowledge of one of ordinary skill in the art, or from the nature of the problem to be solved. See In re Dembiczak, 175 F.3d 994, 1000, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999). Although a reference need not expressly teach that the disclosure contained therein should be combined with another, the showing of combinability, in whatever form, must nevertheless be “clear and particular.” Dembiczak, 175 F.3d at 999, 50 USPQ2d at 1617.

If there was no motivation or suggestion to combine selective teachings from multiple prior art references, one of ordinary skill in the art would not have viewed the present invention as obvious. See In re Dance, 160 F.3d 1339, 1343, 48 USPQ2d 1635, 1637 (Fed. Cir. 1998); Gambro Lundia AB, 110 F.3d at 1579, 42 USPQ2d at 1383 (“The absence of such a suggestion to combine is dispositive in an obviousness determination.”).

Significantly, where there is no apparent disadvantage present in a particular prior art reference, then generally there can be no motivation to combine the teaching of another reference with the particular prior art reference. Winner Int'l Royalty Corp. v. Wang, No 98-1553 (Fed. Cir. January 27, 2000).

Merely identifying some benefit (from hindsight) that results from a combination is not sufficient to justify the combination, and the motivation or suggestion must come from the prior art itself, and the Office Action has failed to identify such proper motivations. As noted above, the Office Action stated that the motivation would be either "to increase the number of electronic elements that can be enclosed within the plasma display" or "to more securely constrain the circuit board to the back cover." Further, there must be a proper teaching or suggestion (within the prior art itself) for the particular features being combined. This suggestion must be something more than simply a utilitarian benefit that is observed from hindsight.

For at least this additional reason that the Office Action failed to identify proper motivations or suggestions for combining the various references to properly support the rejections under 35 U.S.C. § 103, the rejection of claims 10-20 should be withdrawn.

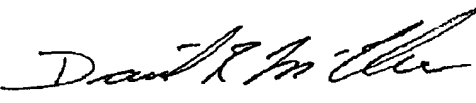
CONCLUSION

For at least the reasons described above, all claims are now in condition for allowance.

Should Examiner feel that further discussion of the application and the Amendment is conducive to prosecution and allowance thereof, please do not hesitate to contact the undersigned at the address and telephone listed below.

No fee is believed to be due in connection with this Amendment and Response to Office Action. If, however, any fee is believed to be due, you are hereby authorized to charge any such fee to deposit account No. 20-0778.

Respectfully submitted,

By: 
Daniel R. McClure, Reg. No. 38,962

Thomas, Kayden, Horstemeyer & Risley, LLP
100 Galleria Pkwy, NW
Suite 1750
Atlanta, GA 30339
770-933-9500